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EXAMINER

THOMPSON, JAMES A

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/729,302
Filing Date: December 04, 2000
Appellant(s): HANSEN, DAVID R.

MAILED

OCT 20 2006

Technology Center 2600

Mark G. Bocchetti
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06 September 2006
appealing from the Office action mailed 18 February 2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,353,388	Motoyama	10-1994
5,956,736	Hanson et al.	9-1999
5,995,721	Rourke et al.	11-1999
5,978,557	Kato	11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 40, 42-43, 46, 48-50, 52, 54-55, 58 and 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736).

Regarding claims 40 and 52: Motoyama discloses a system (figure 2 and column 3, lines 26-31 of Motoyama) for printing a document having a plurality of pages (column 5, lines 28-35 of Motoyama) comprising a print document management system (PDMS) program for running on a computer (column 5, lines 50-52 of Motoyama), the PDMS program facilitating receiving the document

into the print document management program (column 5, lines 46-52 of Motoyama). The various software modules (figure 3(200-210) of Motoyama) constitute a print document management system and receive the document to be processed (column 5, lines 46-52 of Motoyama).

Motoyama further discloses assigning group identifiers into the document to establish groups of pages in the document (figure 1a(110) and column 3, lines 49-54 of Motoyama); and instructing the computer to send one or more of the groups of pages of the document (column 10, lines 34-40 of Motoyama) to an output data stream for printing (column 11, lines 38-43 of Motoyama).

Motoyama further discloses a program executed by a host computer, and therefore a corresponding graphical user interface (GUI), for altering the document data (column 5, lines 38-42 of Motoyama).

Motoyama does not disclose expressly a GUI that facilitates the steps of receiving, assigning and instructing; and that performing said step of assigning thereby creates an amended document.

Hanson discloses a GUI (figure 6C and column 8, lines 44-47 of Hanson) that is used to open, and thus receive, document data (column 10, lines 30-32 of Hanson); assign identifiers in the

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document (column 11, lines 48-54 of Hanson), and therefore create an amended document (column 11, lines 43-48 of Hanson); and instruct the computer to output the document data (column 13, lines 60-64 of Hanson).

Motoyama and Hanson are combinable because they are from the same field of endeavor, namely digital document data processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to perform the steps of receiving, assigning and instructing, as taught by Motoyama, using a GUI and thus creating an amended document, as taught by Hanson. The motivation for doing so would have been to allow a user to modify the contents of the document and the manner in which said document is printed (column 4, lines 34-39 of Hanson). Therefore, it would have been obvious to combine Hanson with Motoyama to obtain the invention as specified in claims 40 and 52.

Further regarding claim 40: The system of claim 52 performs the method of claim 40.

Regarding claims 42 and 54: Motoyama discloses that the print operator instructs the computer to send some or all of the document (column 10, lines 34-40 of Motoyama) to one or more printing devices (column 11, lines 38-43 of Motoyama).

Regarding claims 43 and 55: Motoyama discloses that a printing device processes the amended document that it receives from the computer (column 11, lines 38-41 of Motoyama) and prints one or more pages of the amended document (column 11, lines 41-43 of Motoyama).

Further regarding claims 46 and 58: Hanson discloses that the PDMS receives the input identifiers through the GUI (figure 6C(610) and column 11, lines 27-30 of Hanson) by prompting the printer operator to select group identifiers from a list of identifiers (figure 6C(620) and column 11, lines 42-44 of Hanson).

Further regarding claims 48 and 60: Hanson discloses that the assignment of group identifiers (column 6, lines 59-64 of Hanson) is made by entering an address or other label (figure 6C(610) and column 11, lines 27-30 and lines 42-44 of Hanson) that instructs the computer to format the groups for compatibility with input requirements of a printing device (column 13, lines 52-55 and column 14, lines 6-10 of Hanson). The document is saved as an object instead of as raw data (column 13, lines 52-55 of Hanson), said object formatted based on the various identifiers input by the operator for the various portions of said document (figure 6C(610) and column 11, lines 27-30 and lines 42-44 of Hanson). The document is then output

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based on the definitions given in the object data at the specific output device from which the document is to be output (column 14, lines 6-10 of Hanson), thus formatting the document group for compatibility with input requirements of the printing device.

Regarding claims 49 and 61: Motoyama discloses defining a plurality of page sets (figure 1A(104) of Motoyama) from the overall document body (figure 1A(102) of Motoyama) based on page set definitions (column 4, lines 13-23 of Motoyama). Therefore, if the selected pages of a first page set overlap the selected pages of a second page set, then at least one page of the document will belong to more than one group of pages.

Further regarding claims 50 and 62: Hanson discloses that the identifiers define the content of the portions of the document (column 12, lines 1-6 of Hanson). Therefore, if a group of document pages do not have an identifier, then said group of document pages is a null page group.

Claims 41, 44, 47, 53, 56 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736) and Rourke (US Patent 5,995,721).

Regarding claims 41 and 53: Motoyama discloses printing multiple groups of pages (column 10, lines 34-40 of Motoyama).

Motoyama in view of Hanson does not disclose expressly that said print operator instructs the computer to send multiple groups of pages simultaneously.

Rourke discloses a print operator instructing a computer to send multiple groups of pages simultaneously (figure 6; column 8, lines 16-19; and column 9, lines 18-23 of Rourke).

Motoyama in view of Hanson is combinable with Rourke because they are from the same field of endeavor, namely digital document data processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the user to select a printer from a plurality of printers for each group of pages to be printed, thus sending multiple groups of pages simultaneously, as taught by Rourke. The motivation for doing so would have been to print each group of pages based on the attributes of said group of pages, since each printer prints different types of print data differently (column 10, lines 19-26 of Rourke). Therefore, it

would have been obvious to combine Rourke with Motoyama in view of Hanson to obtain the invention as specified in claims 41 and 53.

Regarding claim 44 and 56: Motoyama discloses printing multiple groups of pages (column 10, lines 34-40 of Motoyama).

Motoyama does not disclose expressly that said print operator may select multiple groups of pages simultaneously for printing by inputting the identifiers for respective page groups to the computer.

Hanson discloses a print operator inputting the identifiers for respective page groups to the computer (column 11, lines 43-48 of Hanson) and printing the document based on the various inputted identifiers (column 13, lines 60-64 of Hanson).

Motoyama and Hanson are combinable because they are from the same field of endeavor, namely digital document data processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have an operator enter identifiers for document portions, as taught by Hanson, said document portions being the different groups of pages taught by Motoyama. The motivation for doing so would have been to allow an operator to output document data specifically in the format that the operator desires (column 14,

lines 4-10 of Hanson). Therefore, it would have been obvious to combine Hanson with Motoyama.

Motoyama in view of Hanson does not disclose expressly that said print operator may select multiple groups of pages simultaneously for printing by inputting the identifiers for respective page groups to the computer.

Rourke discloses a print operator may select multiple groups of pages simultaneously for printing (figure 6; column 8, lines 16-19; and column 9, lines 18-23 of Rourke).

Motoyama in view of Hanson is combinable with Rourke because they are from the same field of endeavor, namely digital document data processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the user to select a printer from a plurality of printers for each group of pages to be printed, thus sending multiple groups of pages simultaneously, as taught by Rourke, based on the identifiers that have been inputted by the operator, as taught by Hanson. The motivation for doing so would have been to print each group of pages based on the attributes of said group of pages, since each printer prints different types of print data differently (column 10, lines 19-26 of Rourke). Therefore, it would have been obvious to combine

Rourke with Motoyama in view of Hanson to obtain the invention as specified in claims 44 and 56.

Regarding claims 47 and 59: Motoyama in view of Hanson does not disclose expressly that the PDMS prompts the printer operator to associate each identifier with a printing device.

Rourke discloses prompting a printer operator to associate each identifier with a printing device (figure 6 and column 8, lines 16-25 of Rourke).

Motoyama in view of Hanson is combinable with Rourke because they are from the same field of endeavor, namely digital document data processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to map user selected document property identifiers to printers based on printer properties, as taught by Rourke. The motivation for doing so would have been print each group of pages based on the attributes of said group of pages, since each printer prints different types of print data differently (column 10, lines 19-26 of Rourke). Therefore, it would have been obvious to combine Rourke with Motoyama in view of Hanson to obtain the invention as specified in claims 47 and 59.

Claims 45 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736) and well-known prior art.

Further regarding claims 45 and 57: Hanson discloses that the PDMS receives the input identifiers through the GUI (figure 6C(610) and column 11, lines 27-30 of Hanson) by prompting the printer operator to select group identifiers from a list of identifiers (figure 6C(620) and column 11, lines 42-44 of Hanson).

Motoyama in view of Hanson does not disclose expressly that the printer operator is prompted to type the group identifiers into a dialog box.

Official Notice is given that entering text data into a dialog box is old, well-known and expected in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to type the group identifiers into a dialog box rather than select the group identifiers from a list, as specifically taught by Hanson. The suggestion for doing so would have been that typing text into a dialog box is one of the many types of data entry available to a computer user.

Claims 51 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US Patent 5,353,388) in view of Hanson (US Patent 5,956,736) and Kato (US Patent 5,978,557).

Regarding claims 51 and 63: Motoyama in view of Hanson does not disclose expressly replacing pages that do not have any identifiers with a media insertion command.

Kato discloses replacing a page that is not to be printed on a particular printer with a media insertion command (column 5, lines 39-42 of Kato).

Motoyama in view of Hanson is combinable with Kato because they are from the same field of endeavor, namely digital document processing and printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to output blank pages when there is no data for that page for the printer, as taught by Kato. The motivation for doing so would have been keep track of where the pages with no identifiers are when printing a document on multiple printers (column 5, lines 43-49 of Kato). Therefore, it would have been obvious to combine Kato with Motoyama in view of Hanson to obtain the invention as specified in claims 51 and 63.

(10) Response to Argument

Appellant's arguments from page 3, line 2 to page 5, line 18:

Appellant argues that Motoyama (US Patent 5,353,388) and Hanson (US Patent 5,956,736) have been brought together through impermissible hindsight and the teaching of Appellant's specification (see page 3, lines 5-33 and page 4, line 22 to page 5, line 10 of Appeal Brief). Further, Appellant argues that:

"Examiner argues 'Motoyama and Hanson are combinable because they are from the same field of endeavor, namely digital document data processing'. This argument, however, falls short of the necessary standard to create a prima facie obviousness suggestion, or motivation."

and therefore the combination of Motoyama and Hanson lacks motivation to make the combination (see page 5, lines 11-18 of Motoyama).

Examiner responds that the motivation to combine the Motoyama and Hanson is clearly set forth in the final rejection mailed 18 February 2005. Therein, Examiner stated:

"Motoyama and Hanson are combinable because they are from the same field of endeavor, namely digital document

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data processing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to perform the steps of receiving, assigning and instructing, as taught by Motoyama, using a GUI and thus creating an amended document, as taught by Hanson. The motivation for doing so would have been to allow a user to modify the contents of the document and the manner in which said document is printed (column 4, lines 34-39 of Hanson). Therefore, it would have been obvious to combine Hanson with Motoyama to obtain the invention as specified in claims 40 and 52." [see page 3, line 25 to page 4, line 6 of said final rejection]

Thus, the motivation to combine Motoyama and Hanson is found directly within the Hanson reference itself (column 4, lines 34-39 of Hanson, as cited above). Appellant has incompletely quoted Examiner's statements, thus creating a false impression of Examiner's position. The quote presented by Appellant is the statement from said final rejection which demonstrates that Motoyama and Hanson are analogous art, which is one of the requirements of an obviousness rejection. The statement of motivation is clearly given in the same paragraph, and was apparently discounted by Appellant. The recited claim

limitations are fully taught by the combination of Motoyama and Hanson (see, for example, from "Regarding claims 40 and 52" on page 2 to page 3, line 24 of said final rejection), Motoyama and Hanson are analogous art (see page 3, lines 25-27 of said final rejection), the level of ordinary skill has been ascertained and the manner in which Motoyama and Hanson are combined is set forth (see page 3, line 27 to page 4, line 1 of said final rejection), and the motivation to combine the references comes directly from the references themselves (see page 4, lines 1-4 of said final rejection). Thus, Appellant's disclosure has not at all been relied upon. Only the prior art references have been relied upon to teach the recited claims. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues that certain aspects of the invention are not taught by Motoyama and Hanson (see page 4, lines 1-21 of Appeal Brief).

Examiner responds that, while Motoyama does not teach a Graphical User Interface ("GUI"), which was conceded by Examiner on page 3, lines 14-17 of said final rejection, Motoyama does teach the steps of receiving, assigning and instructing (see page 3, lines 1-9 of said final rejection). The steps of receiving, assigning and instructing are simply not performed using a GUI. Hanson teaches the use of a GUI (see page 3, lines 18-24 of said final rejection). The fact that the type of document language manipulated by the GUI taught by Hanson may later be placed on the World Wide Web is not particularly relevant to the recited claims or the rejections. The fact that the electronic document may be placed on the World Wide Web is merely an intended use. An electronic document is an electronic document. It can remain on a computer hard drive or be uploaded to the World Wide Web. The World Wide Web itself is simply a collection of connected computers, including server computers, and not some ethereal medium. Thus, in either case, the electronic document is residing and being read on a computer.

As shown clearly in figure 6C of Hanson, the various objects of the electronic document are edited with an Object

Editor, thus creating an amended document (see also column 11, lines 43-54 of Hanson, as cited in said final rejection).

The limitations that Appellant states are not taught by Hanson (see page 4, lines 14-21 of Appeal Brief) have not been argued by Examiner. Appellant is not addressing the actual rejection made in said final rejection, but is simply stating that Hanson does not teach most of the limitations of claim 40, which is something Examiner has never stated. Motoyama teaches most of the limitations of claim 40. Hanson has merely been relied upon to teach that the operations of the print system are performed using a GUI, thus creating an amended document. Allowing the user to modify the contents of the document and the manner in which the document is printed, which is the motivation to combine Motoyama and Hanson found in Hanson, would clearly be desirable by one of ordinary skill in the art at the time of the invention since print jobs often need to be modified based on the present condition of the printing system or the present desires of the operator. A GUI is generally considered the most user-friendly and efficient means by which an operator can interface with a computer-based system.

Appellant's arguments from page 5, line 20 to page 6, line 27:

Appellant argues that there is no motivation to combine Motoyama, Hanson and Rourke (US Patent 5,885,721) and Examiner is thus using impermissible hindsight; and that Rourke does not disclose "a Print Document Management System which permits a print operator to assign group identifiers into a document to establish groups of pages in the document".

Examiner responds that Rourke has not been relied upon to teach "a Print Document Management System which permits a print operator to assign group identifiers into a document to establish groups of pages in the document", as can clearly be seen on page 6, lines 1-6 of said final rejection.

The motivation to combine Motoyama and Hanson has already been addressed above, and does not therefore need to be repeated here. The motivation to combine Rourke with Motoyama and Hanson comes directly from Rourke, as shown on page 6, lines 14-17 of said final rejection. The recited limitations of the claims not taught by Motoyama and Hanson are taught by Rourke, as set forth (for example) on page 6, lines 1-6 of said final rejection. Rourke is analogous art, as demonstrated on page 6, lines 7-9 of said final rejection. The level of ordinary skill was determined and the manner of combination set forth, as

demonstrated on page 6, lines 9-14 of said final rejection. The motivation to combine is taken *directly from Rourke*, as clearly demonstrated on page 6, lines 14 of said final rejection. Thus, Appellant's disclosure has clearly not been relied upon to teach the recited claims. Again, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant's arguments from page 6, line 29 to page 7, line 18:

Appellant argues that improper hindsight is employed in the combination of Motoyama, Hanson and well-known prior art.

Examiner responds that, firstly, Appellant is merely alleging that improper hindsight is employed. Appellant has not addressed the rejections made in said final rejection and the corresponding suggestion to combine that was clearly set forth on page 9, lines 6-13 of said final rejection, and has merely alleged that improper hindsight is employed.

The suggestion to combine would have been that typing text into a dialog box is one of the many types of data entry available to a computer user. Hanson already teaches the use of a Graphical User Interface. A dialog box is a common feature in Graphical User Interfaces, and a user must enter the data somehow. Using a dialog box, and the advantages of using a dialog box would have been well-known to one of ordinary skill in the art at the time of the invention. Thus, using a dialog box is simply an obvious design choice based on the well-known prior art. Without some means of data entry, the GUI is useless and, in fact, is not even a GUI since there is no longer any kind of user interface.

Appellant's arguments from page 7, line 20 to page 8, line 13:

Appellant argues that there is no motivation to combine Kato (US Patent 5,978,557) with Motoyama and Hanson; and that Kato does not teach "a Print Document Management System which permits a print operator to assign group identifiers into a document to establish groups of pages in the document."

Examiner responds that Kato has not been relied upon to teach "a Print Document Management System which permits a print operator to assign group identifiers into a document to

establish groups of pages in the document", as can clearly be seen on page 9, lines 18-23 of said final rejection.

The motivation to combine Kato with Motoyama and Hanson comes directly from Kato, as clearly set forth on page 9, line 29 to page 10, line 2 of said final rejection. The claim limitations not taught in either Motoyama and Hanson are taught in Kato, as set forth on page 9, lines 18-23 of said final rejection. Kato and Motoyama in view of Hanson are analogous art, as set forth on page 9, lines 24-26 of said final rejection. The manner in which Kato is combined with Motoyama and Hanson, based on the level of ordinary skill in the art at the time of the invention, is clearly set forth on page 9, lines 26-29 of said final rejection. Finally, the motivation, which is derived from the Kato reference itself and not from Appellant's disclosure, is set forth on page 9, line 29 to page 10, line 2 of said final rejection. Since all of the teachings relied upon to teach the limitations of claims 51 and 63 have come directly from the references themselves, then no impermissible hindsight reconstruction has been applied. Again, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the

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claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

James A. Thompson



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